

REMARKS

Claims 1 and 3-34 are currently pending in the subject application and are presently under consideration. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments herein.

I. Rejection of Claims 1 and 3-34 Under 35 U.S.C. §101

Claims 1 and 3-34 stand rejected under 35 U.S.C. §101 because it is alleged the subject claims are not statutory as they to recite a number of computing steps without producing tangible result and/or being limited to practical application within the technological art. This rejection should be withdrawn for at least the following reasons. The subject claims recite a useful, concrete and tangible result.

Independent claims 1, 13, and 29 each produce one or more useful, concrete and tangible result. Independent claim 1 recites: *a computer system that facilitates management of a file system filter*, comprising: *at least one minifilter that has an integer altitude value associated therewith*; and *a filter manager that maps altitudes of the at least one minifilter to legacy filter order groups*. As can be seen independent claim 1 provides a computer system that facilitates management of a file system filter. In order to facilitate such management of the file system filter, a filter manager maps integer altitude values associated with at least one minifilter legacy filter order groups. It is submitted that the aforementioned results are useful, concrete and tangible, as such results allow for coexistence between legacy filters already part of a file system and new filters, thus mitigating the need for developers of legacy filters to perform substantial modification on legacy filters in order to ensure coexistence with new filters.

Further, independent claim 13 provides: a computer implemented method for managing a file system filter, comprising: loading at least one minifilter to a file system; and determining an integer altitude value associated with the at least one minifilter. The subject claim, like independent claim 1, recites useful, concrete and tangible results, namely, a computer-implemented method for managing a file system filter, loading at least one minifilter to a file system, and determining an integer altitude value associated with the at least one loaded minifilter.

Moreover, independent claim 29 recites one or more useful concrete and tangible results, namely: mapping integer value altitudes of minifilters to legacy filter order groups, and determining an altitude interval associated with at least one frame, thereby facilitating management of a file system filter.

Additionally, as was stated in the Reply to Office Action dated January 26, 2006, and is reiterated herein, the Examiner appears once again to be under the misapprehension that 35 U.S.C. §101 requires claims to contain limitations to practical applications in the technological arts. Appellants' representative disagrees. United States patent law has never supported the application of a "technological aspect" or "technological arts" requirement. Title 35 of the United States Code does not recite, explicitly or implicitly, that inventions must be within the "technological arts" to be patentable. Section 101 of Title 35 recites "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore ..." Accordingly, while an invention must be "new" and "useful," there is no statutory requirement that it fit within a category of "technological arts." Moreover, while there has been some judicial discussion of the expression "technological arts" and its relationship to patentability, this dialogue has been limited and its viability questioned. In 1970, the Court in *In re Musgrave*, 431 F.2d 882, 167 USPQ 280 (CCPA 1970) introduced a standard for evaluating process claims under Section 101: any sequence of operational steps is a patentable process so long as it is within the technological arts so as to promote the progress of useful arts. While a few subsequent courts have made reference to this so-called "technological arts" standard, the Supreme Court in *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ 673 (1972) refused to adopt this standard when it reversed the Court of Customs and Patent Appeals decision in the aforementioned case. Moreover, the Court of Customs and Patent Appeals effectively rejected the technological arts test in *In re Toma*, 575 F.2d 872, 878, 197 USPQ 852, 857 (CCPA 1978), by strongly suggesting that *Musgrave* was never intended to create a technological arts test for patent eligibility:

The language which the examiner has quoted [from *Musgrave* and its progeny relating to "technological arts"] was written in answer

to “mental steps” rejections and was not intended to create a generalized definition of statutory subject matter. Moreover, it was not intended to form a basis for a new § 101 rejection as the examiner apparently suggests. *In re Toma*, 575 F.2d at 878, 197 USPQ at 857.

Moreover, the “technological arts” consideration is completely devoid from recent Federal Circuit cases like *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, (Fed. Cir. 1999), and *State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601 (Fed.Cir.1998).

It is submitted that the “technological arts” requirement propounded by *Musgrave* should be confined to its facts and holding, *i.e.*, that the computer-related invention in dispute was a patentable invention within the meaning of Section 101 because it was an advancement in technology which clearly promoted the useful arts. Thus, the decision in *Musgrave* should not be construed as a “technological arts” requirement for patentability, but rather as a proposition that computer-implemented process claims might be patentable subject matter.

Further, in *Ex parte Lundgren*, Appeal No. 2003-2088, Application 08/093,516, (Precedential BPAI opinion September 2005), the Board rejected the Examiner’s argument that *Musgrave* and *Toma* created a technological arts test. “We do not believe the court could have been any clearer in rejecting the theory the present examiner now advances in this case.” *Lundgren*, at 8. The Board held that “there is currently no judicially recognized separate ‘technological arts’ test to determine patent eligible subject matter under § 101.” *Lundgren*, at 9. Thus, in view of the foregoing it is evident that there are no recognized exceptions to eligible subject matter other than laws of nature, natural phenomena, and abstract ideas.

In view of at least the foregoing, it is apparent that applicants’ claimed invention produces a useful, concrete and tangible result pursuant to *AT&T Corp. v. Excel Communications, Inc.*, and the Examiner’s contention that the subject claims must be limited to a practical application within the technological arts lacks support from either 35 U.S.C. §101 or the Federal Courts’ precedential interpretation thereof. Accordingly,

withdrawal of this rejection with respect to independent claims 1, 13, and 29 (and claims that depend there from) is requested.

II. Rejection of Claims 1 and 3-34 Under 35 U.S.C. §102(e)

Claims 1 and 3-34 stand rejected under 35 U.S.C. §102(e) as being anticipated by Golds *et al.* (US2001/0020245). This rejection should be withdrawn for at least the following reasons. Golds *et al.* fails to disclose or suggest all features recited in the subject claims.

For a prior art reference to anticipate, 35 U.S.C. §102 requires that “*each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999) (*quoting Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)) (emphasis added).

Applicants’ claimed subject matter relates generally to computer systems, and more particularly to systems and methods that facilitate ordering of file systems and file system filters. In one instance, the claimed subject matter provides a filter manager that allows coexistence between legacy filters already extant as part of a file system and newer filters, thereby facilitating management of the priority and/or ordering of such filters and their execution. Such a filter manager infrastructure can mitigate the necessity for developers of legacy filters to perform substantial modification on these filters because the disclosed management infrastructure seamlessly allows legacy filters to coexist with newer filters. Accordingly, applicants’ claimed subject matter permits filter managers to insert newer “minifilters” between other filters to create a new filter framework. Working within a legacy filter framework, minifilters can be moved as desired. Moreover, minifilters can dynamically change their own position as desired, and as such advantageously enhances the ability of a filter manager to sort incoming requests. To this end, independent claim 1 (and similarly, independent claims 13 and 29) recites: at least one minifilter that has an integer altitude value associated therewith. Golds *et al.* fails to disclose or suggest this aspect of the invention as claimed.

Golds *et al.* discloses a system and method for ordering software modules in a guaranteed order for execution wherein unique ordering values are statically assigned to software modules. The Examiner contends that the cited document discloses the pertinent aspect of the subject claims at page 4, paragraphs 0033 and 0035. Page 4, paragraph 0033 provides for the assignment of ordering values to drivers, wherein the drivers, based on their functionality, are grouped into classes such that within each class various rules can be employed to assign ordering values to the drivers. Page 4, paragraphs 0035-0036 further provides that once classified into a group, each driver is given an ordering value in a range based on its class type that is a floating-point value. The ordering value taking the form of 0.ABBB, where the first character identified by “A” is employed to define a general class or family of driver types, and the characters “BBB” are utilized to order individual drivers within the general class of driver types. The claimed subject matter in contrast, employs and assigns integer values to facilitate ordering of file systems and file system filters, rather than assigning floating point values to software modules. As would be understood by those of ordinary skill in the art there is a clear distinction, albeit subtle, between floating point and integer representations. An integer, as would be comprehended by those cognizant in the art, is a whole number (*e.g.*, a natural number, a number that is neither a fraction nor a mixed fraction). A floating point number in contrast is not an integer as it is representative of numbers with fractional parts to them. It is thus clearly apparent that applicants’ claimed subject matter and the cited document are distinguishable. Accordingly, withdrawal of this rejection with respect to independent claims 1, 13 and 29. and associated dependent claims, is requested.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP530US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

AMIN, TUROCY & CALVIN, LLP

/Himanshu S. Amin/

Himanshu S. Amin

Reg. No. 40,894

AMIN, TUROCY & CALVIN, LLP
24TH Floor, National City Center
1900 E. 9TH Street
Cleveland, Ohio 44114
Telephone (216) 696-8730
Facsimile (216) 696-8731